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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,219	10/20/2000	Paul Lapstun	NPA031US	7823
24011	7590	03/14/2005	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			PHAM, THIERRY L	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/693,219

Applicant(s)

LAPSTUN ET AL.

Examiner

Thierry L Pham

Art Unit

2624

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 February 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1,2,6-13 and 15-30.
Claim(s) withdrawn from consideration: 3-5, 14.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
Newly added limitations "includes marking associated with digital ink, markings not associated with digital ink; and duplicates the markings associated with digital ink but does not duplicate the markings not associated with digital ink" found in claims 1-2, 15, 18-19 raise new issues that would require further consideration and/or search.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

GABRIEL GARCIA
PRIMARY EXAMINER

U.S. Patent and Trademark Office
PTOL-303 (Rev. 9-04)

Advisory Action Before the Filing of an Appeal Brief

Part of Paper No. 20050217

Appl. No. 09/693,219
Amdt. Dated February 7, 2005
Response to Office action of December 6, 2004

3

Amendments to the Claims:

This listing of claims will replace all prior versions, and listings, of claims in the application:

Listing of Claims:

1. (Currently amended) A method enabling the copying of documents, the method including the steps of:

scanning a document that ~~contains both document information~~ includes markings associated with digital ink, markings not associated with digital ink, and coded data indicative of an identity of the document, and forming a digital image of the document;

detecting the coded data;

accessing stored data representing the content of the document;

identifying differences between the digital image and the stored data; and

printing a copy of the document and, at the same time, printing on the copy coded data indicative of an identity of the copy;

wherein the printed copy of the document ~~includes information derived from both the digital image of the document and the stored data representing the content of the document~~ duplicates the markings associated with digital ink but does not duplicate the markings not associated with digital ink.

2. (Currently amended) A method enabling the copying of documents, the method including the steps of:

scanning a document that ~~contains both document information~~ includes markings associated with digital ink, markings not associated with digital ink and coded data indicative of an identity of the document, and forming a digital image of the document;

detecting the coded data;

accessing stored first data representing the content of the document;

identifying differences between the digital image and the stored first data and

storing second data representing a copy of the document, the stored second data including a unique identifier for the copy;

wherein the stored second data representing a copy of the document ~~includes information derived from both the digital image of the document and the stored first data representing the content of the document~~ duplicates the markings associated with digital ink but does not duplicate the markings not associated with digital ink.

Appia No. 09/693219
Amtd. Dated February 7, 2005
Response to Office action of December 6, 2004

4

3-5. (Cancelled)

6. (Original) A method according to claim 1, wherein said coded data indicative of an identity of the copy is indicative of a plurality of reference points on said copy, the coded data being printed to be readable by a sensing device operated by a user in order to identify the position of the sensing device relative to the copy.

7. (Currently amended) A method according to claim 1, including the step of storing data representing said copy of the document, to enable reproduction of said copy with both ~~document information~~ markings and coded data.

8. (Previously presented) A method according to claim 2 or claim 7, the storing second data step involving archiving said second data and allocating a unique identifier for each said copy.

9. (Previously presented) A method according to claim 8, the archiving of the second data and the allocating of said unique copy identifier being realised by respective computer servers.

10. (Previously presented) A method according to claim 2 or claim 7, the storing second data step being carried out in a location remote from the scanning or the printing steps.

11. (Previously presented) A method according to claim 2 or claim 7, including the step of carrying out optical character recognition (OCR) on at least part of the content of the scanned document, and associating the result of said OCR with said stored second data representing said copy of the document, to enable searching of the content of said copy.

12. (Original) A method according to claim 1 or claim 2, wherein said coded data is substantially invisible to the eye.

13. (Currently amended) A method according to claim 1 or claim 2, wherein said coded data is visible to the eye, and embedded within visible ~~document information~~ markings.

Appln No. 09/593,219
Amdt. Dated February 7, 2005
Response to Office action of December 6, 2004

5

14. (Cancelled)

15. (Currently amended) A method according to claim 1, wherein an operator may choose whether said copy of the document ~~includes information derived from the digital image of the document~~ duplicates the markings associated with digital ink but does not duplicate the markings not associated with digital ink.

16. (Original) A method according to claim 1, including an authorisation step before said printing step can be carried out.

17. (Original) A method according to claim 1, wherein the copy is a multipage document, including the step of binding together the printed pages.

18. (Currently amended) A system enabling the copying of documents, including:
a scanner for scanning a document that ~~contains both document information~~ includes markings associated with digital ink, markings not associated with digital ink, and
coded data indicative of an identity of the document and enabling formation of a digital image of the document;

a detector for detecting the coded data;

a data store including data representing document content; and

a printer adapted for printing a copy of the document and, at the same time, printing on the copy coded data indicative of an identity of the copy, wherein the printed copy of the document ~~includes information derived from both the digital image of the document and the data representing document content~~ duplicates the markings associated with digital ink but does not duplicate the markings not associated with digital ink.

19. (Currently amended) A system enabling the copying of documents, including:

a scanner for scanning a document that ~~contains both document information~~ includes markings associated with digital ink, markings not associated with digital ink, and
coded data indicative of an identity of the document and enabling formation of a digital image of the document;

a detector for detecting the coded data;

a first data store including data representing document content; and

a second data store including data representing a copy of the document, together

Appin No. 09/593.219
Amtd. Dated February 7, 2005
Response to Office action of December 6, 2004

6

with a unique identifier for the copy;

wherein data in the second data store representing a copy of the document ~~includes information derived from both the digital image of the document and the data in the first data store representing document content~~ duplicates the markings associated with digital ink but does not duplicate the markings not associated with digital ink.

20. (Previously presented) A system according to claim 19, including a server for allocating a unique identifier to the copy.

21. (Previously presented) A system according to claim 19 connectable with a printer adapted for printing the copy of the document and, at the same time, printing on the copy coded data indicative of an identity of the copy.

22. (Original) A system according to claim 18 or claim 21, including a sensing device operable by a user to identify said coded data printed on said copy.

23. (Original) A system according to claim 22, the sensing device including a marking nib.

24. (Original) A system according to claim 22, the sensing device including an identification means which imparts a unique identity to the sensing device, the system able to associate the identifier for the copy with the identity of the sensing device.

25. (Original) A system according to claim 18 or claim 21, the printer including a binder for binding the pages of a multi-page copy.

26. (Original) A system according to claim 18 or claim 21, the scanner and the printer being provided as parts of a single apparatus.

27. (Original) A system according to claim 18 or claim 19, the scanner and the detector being provided as parts of a single apparatus.

28. (Original) A system according to claim 27, the scanner comprising a moving linear image sensor device, the detector carried by this device.

Appln No. 09/693,219
Amdt. Dated February 7, 2005
Response to Office action of December 6, 2004

7

29. (Original) A system according to claim 22, the sensing device adapted to communicate with a base station, the scanner and the base station provided as parts of a single apparatus.

30. (Original) A system according to claim 18 or claim 19, including authorisation means to prevent use by an unauthorised user.